III. Remarks and Conclusion

A. Restriction of June 16, 2004

In response to the Restriction requirement of June 16, 2004, Applicants respectfully traverse. Notwithstanding such traversal, Applicants elect Group I, with a subgroup 1 of benzyl β-alaninate, a subgroup 2 of sodium chloride, a subgroup 3 of ethyl acetate, and a subgroup 4 of 20°C, all with traversal.

To begin, Applicant traverses the restriction between Groups 1 and 2. The Examiner has failed to specify how such Claims would be an undue burden. Claim 47, the second Group, depends from Claim 28, the first independent Claim of Group I. Accordingly, it carries all of the limitations of Group I, i.e. Group II carries all the limitations of Group I. Applicant fails to see how searching Group I and II is a burden. Therefore, Applicants respectfully request reconsideration.

Title 35 USC, Section 121 states that the office (Commissioner) may require restriction if two or more "independent and distinct" inventions are claimed in one application. Title 37 CFR, Section 1.141 positively states that two or more independent and distinct may not be claimed in one application. Here, in the present application, it is difficult to determine how the Examiner has discovered two independent and distinct inventions. Here, there is a definite relationship between the Claims, as Claim 47 (Group II) depends from Claim 28 (Group I). Accordingly, the Claims are not independent. Likewise, Claim 47 is not distinct from Claim 28. Claim 47 simply further limits Claim 28. Accordingly, the two Groups are not distinct. Therefore, as the two Groups are neither Independent nor distinct, the restriction is improper and Applicants respectfully request reconsideration.

Further, Applicant specifically responds with traverse as to the restriction requirement of the subgroups.

The Examiner has not properly conducted a restriction requirement nor stated why why the species are patently distinct. The Examiner has made a broad allegation that the species are distinct because their modes of action are different. Further, the Examiner states that the species would differ in their reactivity and the starting material from which they were made. As well, the Examiner states that the method steps for each species would differ. Lastly, the Examiner maintains that the species can be separately classified. The Examiner then surmises that the species have different issues regarding patentability and represent patentably distinct subject matter. However, Applicant asserts that the Examiner has failed to lay the proper predicate.

For subgroup 1, Applicants confirm the election of benzyl β-alaninate.

As for subgroup 2, Applicants assert that the restriction to a single species of extraction reagent is incorrect. As stated above, the Examiner has not properly established a necessity for restriction. The Examiner's Practice Guide, the MPEP, in Section 806.04(b), clearly states that restriction to a species is not proper unless proper under the guidelines for the restriction/election of species and proper under the guidelines for other restrictions. To say the least, the alleged species must be independent. Here, the Examiner has not identified the species so it is impossible to make a determination. Applicants respectfully request removal of this alleged species restriction. The Examiner has not stated a valid reason to have the extraction reagents restricted. Accordingly, Applicants respectfully request reconsideration.

For subgroup 3, the Examiner has not identified the various species nor has the Examiner

stated any reasons why the organic solvents satisfy the requirements for restriction of species. Vague statements are no evidence of support. Accordingly, Applicants respectfully request reconsideration of the restriction of species as to organic solvents.

For subgroup 4, species of temperature, Applicant respectfully requests reconsideration. To begin, on a practical side, Applicant finds it hard to imagine that a temperature range creates species. Further, the Examiner has not indicated how this is possible. Accordingly, Applicants respectfully request reconsideration of the restriction of species.

B. Restriction of March 13, 2003 from related case 10/199,805

Previously, in the preliminary amendment of October 22, 2003, Applicants elected a species of benzyl β-alaninate or a salt thereof for prosecution with an election of Group II from the restriction requirement made in the parent case, 10/199,805, filed July 19, 2002. No action has been taken on the present case and a search not performed. Accordingly, Applicants specifically traverse the previous restriction requirement and election of Group II from the parent case However, Applicants still choose a species of benzyl β-alaninate or a salt thereof for prosecution.

The Restriction Requirement made in the parent case is attached as Exhibit A to this Preliminary Amendment, for the Examiner's convenience.

Applicants contend that Groups I and II and Groups II and IV should be rejoined in the restriction requirement made in the parent case. The only difference between Group I and Group II is that the amine scavenger "is used for deprotection" and "is not used for deprotection." Likewise, the only difference between Group III and Group IV is that the thiol scavenger "is used

for deprotection" and "is not used for deprotection." A search comprising the scavengers being used for deprotection or not used for deprotection would not be burdensome on the Examiner and would be economical for the patent office resources because the inventions are not independent and distinct.

There are two requirements for a proper restriction to be issued. First, the inventions must be independent or distinct as claimed. See MPEP §802.01. Second, there must be a serious burden on the Examiner to search the invention. See MPEP §803.02.

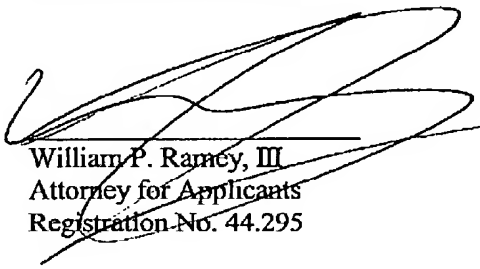
MPEP §802.01 provides the definitions for independent and distinct. Independent is defined as 'not dependent,' that there is no relationship between the two or more subjects disclosed, they are unconnected in design, operation or effect. The term distinct means that two or more subjects as disclosed are related and are patentable over each other. Here, Applicants contend that there is the inventions are neither independent nor distinct.

The Examiner's reasons for restriction of Groups I-IV is that each of the methods is different because they use different steps. (See Restriction Requirement of USSN 10/199,805, attached as Exhibit A). The Examiner's sole difference is that in Groups I and III the scavenger is 'used for deprotection,' while in Groups II and IV the scavenger 'is not used for deprotection.' The Examiner contends that these are different steps. Applicants assert that an application of the standard for restrictions to the inventions of the present application establishes that restriction is not proper as to whether or not the scavenger is used for deprotection. Applicants are not arguing the restriction between the amine and thiol compounds, or as to Group V, a mixture of peptides. Applicants solely are asserting that the Restriction Requirement should be rescinded as to Groups I and II and then again as to Groups II and IV.

No further step is required when the scavenger is also used for deprotection compared to when the scavenger is not used for deprotection. Accordingly, the Examiner's premise for making the restriction was incorrect and the restriction not proper. Whether the scavenger acts to deprotect is a property of the scavenger and not a step being added. Accordingly, Applicants respectfully request that the requirement be rescinded.

Should the Examiner have any questions, Applicants respectfully invite the Examiner to contact the Applicants' attorney, William P. Ramey, III, at 302-933-4034. The application is believed in a condition for allowance and such action is respectfully requested. The Commissioner is hereby authorized to charge any required fees and to credit any credits to deposit account no. 02-2334.

Respectfully submitted,



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